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09/553,695	04/21/2000	MARVIN T LING	GTX-001	6472

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EXAMINER

KANOF, PEDRO R

ART UNIT PAPER NUMBER

3628

DATE MAILED: 10/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/553,695

Applicant(s)  
LING

Examiner  
KANOF

Art Unit  
3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 6/7/02.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

*Response to Amendments*

1. This correspondence is in response to the amendments filed 6/7/02.
2. Claims 1 and 27 have been amended as requested.
- 3.. Claims 1-27 are rejected.

*Claim Rejections - 35 USC § 112*

4. Claims 1 and 27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new features in Claims 1 and 27 are not supported by the Specification, in particular see page 19.

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*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 27 is rejected under 35 U.S.C. 102(b) as being anticipated by Williams et al. (U.S. Patent No. 5,815,657)(hereafter Williams).

Claim 27: Williams disclose a server operated by a vendor that provides products for sale or rental through a network, the server comprising:

a network interface through which the server communicates with a user over the network (Col. 12, lines 41-46);

a database (Col. 14, lines 24-28);

a memory (Col. 13, line 67-col. 14, lines 6);

a processor that executes software stored in the memory (Col. 15, line 61-col. 16, line 4, and col. 16, lines 22-38), the software including one or more programmed routines, the programmed routines comprising:

a registration routine that opens a user account in the database for the user (Col. 2, lines 9-16 and col. 1, lines 31-42);

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an electronic token sale routine that issues one or more electronic tokens from the vendor to the user, and adds the one or more electronic tokens to the user account (Col. 1, lines 16-26 and col. 17, lines 49-57);

a display routine that displays the prices of the products in units of electronic tokens (Col. 31, lines 2-20);

a selection routine that permits the user to select a subset of the products for purchase, a total price of the subset of the products being computed in units of electronic tokens (Col. 31, lines 24-40); and

a purchase routine that determines if the user account contains electronic tokens having a value equal to or greater than the total price, and if so, subtracts the total price from the user account (Col. 1, lines 27-37 and col. 21, line 24-col. 22, line 25).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. (U.S. Patent No. 5,815,657)(hereafter Williams), and further in view of Fujimoto (U.S. Patent No. 6,018,720).

Claim 1: Williams discloses a method of conducting electronic commerce, the method comprising:

opening a user account with a vendor for a user (debits cards uses accounts with a vendor of a service, Col. 2, lines 9-14 and Col. 1, lines 31-42);

issuing one or more electronic tokens from the vendor to the user, and adding the one or more electronic tokens issued by the vendor to the user account (Col. 14, line 42-Col. 15, line 4);

permitting the user to select a subset of the products and services for purchase (Col. 15, line 61-col. 16, line 3 and col. 18, lines 2-8);

computing a total price for the selected subset of the products and services in units of electronic tokens (Col. 13, lines 41-45).

However, Williams does not explicitly disclose providing products-and services that may be purchased through the vendor, wherein prices for the products and services are listed in units of electronic tokens. Fujimoto discloses providing products-and services that may be purchased through the vendor, wherein prices for the products and services are listed in units of electronic tokens (Col. 15, lines 60-65). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to providing products and services that may be purchased through the vendor, wherein prices for the products and services are listed in units of

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electronic tokens, defining a unit able to pay also calls for few cents, such as in the telephonic industry. One would have been motivated to including this step in order to increase the flexibility of the system.

Williams also discloses the step wherein if the user account contains electronic tokens having a value equal to or greater than the total price, permitting the user to purchase the selected subset of the products and services, and subtracting the total price from the user account (Col. 11, lines 53-63, col. 13, lines 45-53, col. 15, lines 30-52, and col. 16, lines 9-17). Fujimoto also discloses such as a step (Col. 3, lines 18-36). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such a step. One would have been motivated to including this step in order to increase the flexibility of the system.

Claim 2: Williams and Fujimoto disclose the method of claim 1. Williams also discloses issuing one or more electronic tokens from the vendor to the user comprises permitting the user to purchase the one or more electronic tokens from the vendor (Col. 17, lines 49-57).

Claim 3: Williams and Fujimoto disclose the method of claim 2. Williams also discloses permitting the user to purchase the one or more electronic tokens from the vendor comprises permitting the user to conduct an on-line transaction using a credit card to purchase the one or more electronic tokens (Col. 2, lines 9-17, col. 18, lines 27-30 and claim 21, lines 26-28).

Claim 4: Williams and Fujimoto disclose the method of claim 2. Williams also discloses permitting the user to purchase the one or more electronic tokens from the vendor

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comprises permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens (Col.2, lines 18-20).

Claim 5: Williams and Fujimoto disclose the method of claim 4. Williams also discloses permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to use a purchase order to purchase the one or more electronic tokens (Col. 2, lines 20-36).

Claim 6: Williams and Fujimoto disclose the method of claim 4. However, the references does not explicitly disclose permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to request to be billed for the one or more electronic tokens. Official notice is taken that the step of permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to request to be billed for the one or more electronic tokens is old and well known within the art. One would have been motivated to including this step in order to increase the flexibility of the system.

Claim 7: Williams and Fujimoto disclose the method of claim 4. Williams also discloses permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to use phone, fax, mail, or e-mail to purchase the one or more electronic tokens (Col. 1, lines 17-24).



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Claim 8: Williams and Fujimoto disclose the method of claim 4. Williams also discloses permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to purchase electronic tokens without using a credit card (Col. 21, lines 23-28).

Claim 9: Williams and Fujimoto disclose the method of claim 1. wherein issuing the one or more electronic tokens comprises setting a price for the one or more electronic tokens, the price determined by the vendor (Col. 15, lines 60-65). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to issuing the one or more electronic tokens comprises setting a price for the one or more electronic tokens, the price determined by the vendor. One would have been motivated to including this step in order to increase the flexibility of the system.

Claim 10: Williams and Fujimoto disclose the method of claim 1. Williams also discloses wherein opening a user account with a vendor comprises registering the user with the vendor (Col. 2, lines 9-14).

Claim 11: Williams and Fujimoto disclose the method of claim 10. Williams also discloses wherein registering the user with the vendor comprises recording personal information about the user in a database maintained by the vendor (Col. 10, line 65-col. 11, line 4, col. 18, lines 33-37). Also Fujimoto discloses such as a step (Col. 1, lines 23-45).

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Claim 12: Williams and Fujimoto disclose the method of claim 11. Williams also discloses wherein registering the user with the vendor comprises acquiring personal information about the user through off-line communications (Col. 11, lines 31-38)

Claim 13: Williams and Fujimoto disclose the method of claim 10. However, the references does not explicitly disclose wherein opening a user account with the vendor further comprises issuing a predetermined minimum number of electronic tokens to the user. Official notice is taken that the step of opening a user account with the vendor further comprises issuing a predetermined minimum number of electronic tokens to the user is old and well known within the art. One would have been motivated to including this step in order to increase the flexibility of the system.

Claim 14: Williams and Fujimoto disclose the method of claim 1. However, the references does not explicitly disclose comprising issuing additional electronic tokens to the user. Official notice is taken that the step issuing additional electronic tokens to the user is old and well known within the art. One would have been motivated to including this step in order to increase the flexibility of the system.

Claim 15: Williams and Fujimoto disclose the method of claim 14. Fujimoto also discloses wherein issuing additional electronic tokens to the user comprises permitting the user to purchase additional electronic tokens if the user account does not contain enough electronic tokens to cover the total price of the selected subset of products and services (Col. 3, lines 18-46). Therefore, it would have been obvious to one having ordinary skill in the art at the time the

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invention was made to including this step. One would have been motivated to including this step in order to increase the flexibility of the system.

Claim 16: Williams and Fujimoto disclose the method of claim 14. Williams also discloses wherein issuing additional electronic tokens to the user comprises permitting the user to purchase additional electronic tokens through an on-line transaction using a credit card, without disrupting a process of selecting products and services (Col. 17, lines 49-57).

Claim 17: Williams and Fujimoto disclose the method of claim 1. Williams also discloses comprising displaying a number of available electronic tokens in the user account on a computer screen (Col. 18, lines 2-12).

Claim 18: Williams and Fujimoto disclose the method of claim 1. Williams also discloses providing products and services that may be purchased through the vendor comprises providing software to be purchased or rented in exchange for electronic tokens (Col. 18, lines 2-12 and col. 32, line 57-col. 3, line 4).

Claim 19: Williams and Fujimoto disclose the method of claim 18. However, the references does not explicitly disclose providing software to be purchased or rented comprises providing software that is rented for a limited time. Official notice is taken that the step providing software to be purchased or rented comprises providing software that is rented for a limited time is old and well known within the art. One would have been motivated to including this step in order to increase the number of the user's system.

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Claim 20: Williams and Fujimoto disclose the method of claim 18. However, the references does not explicitly disclose providing software to be purchased or rented comprises providing software that is rented for a limited number of uses. Official notice is taken that the step providing software to be purchased or rented comprises providing software that is rented for a limited number of uses is old and well known within the art. One would have been motivated to including this step in order to increase the number of the user's system.

Claim 21: Williams and Fujimoto disclose the method of claim 18. However, the references does not explicitly disclose providing software to be purchased or rented comprises providing software that is rented for processing a given task for a specific number of times. Official notice is taken that the step providing software to be purchased or rented comprises providing software that is rented for processing a given task for a specific number of times is old and well known within the art. One would have been motivated to including this step in order to increase the number of the user's system.

Claim 22: Williams and Fujimoto disclose the method of claim 18. However, the references does not explicitly disclose providing software to be purchased or rented further comprises permitting the user to extend the software rental in exchange for electronic tokens. Official notice is taken that this step is old and well known within the art. One would have been motivated to including this step in order to increase the number of the user's system.

Claim 23: Williams and Fujimoto disclose the method of claim 18. However, the references does not explicitly disclose providing software to be purchased or rented further

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comprises permitting the user to convert rental software to purchased software in exchange for electronic tokens. Official notice is taken that this step is old and well known within the art. One would have been motivated to including this step in order to increase the number of the user's system.

Claim 24: Williams and Fujimoto disclose the method of claim 18. Williams also discloses providing software to be purchased or rented further comprises determining if a selected software program is already installed on a user's computer, downloading and installing the selected software program if the selected software program is not already installed on the user's computer, and sending an authorization code, without downloading the selected software program, if the selected software program is already installed on the user's computer (Col. 1, lines 55-65 and col. 12, lines 10-40)

Claim 25: Williams and Fujimoto disclose the method of claim 1. However, the references does not explicitly disclose comprising transferring electronic tokens from the user to a second user. Official notice is taken that this step is old and well known within the art. One would have been motivated to including this step in order to increase the number of the user's system.

Claim 26: Williams and Fujimoto disclose the method of claim 1. Williams also discloses providing products and services that may be purchased through the vendor comprises listing products and services for sale by one or more users of a Web site maintained by the vendor (Col. 1, lines 39-52, col. 12, lines 49-51 and col. 13, lines 19-20).

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*Response to Arguments*

9. The Applicant's argues that "Williams and Fujimoro fail to show or suggest applicant's claimed features of issuing electronic tokens from a vendor without requiring communication with a financial institution and making purchases without disclosing the user's personal information to the vendor" (Page 7, lines 6-10).

As noted in paragraph 4 above, these features are not supported by the Specification.

Thus, the arguments are moot,

*Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

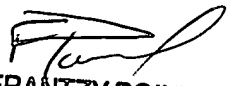
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. Pedro R. Kanof whose telephone number is (703) 308-9552.

The examiner can normally be reached on weekdays from 7:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Vincent Millin, can be reached on (703) 308-1065. The fax phone number for this Group is (703) 308-1396.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

PRK-9/30/2002

  
FRANTZY POINVIL  
PRIMARY EXAMINER  
Au 3628